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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,760	06/07/2001	Markus Scheuber	34183/233887	2221
826	7590	11/16/2004	EXAMINER:	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			CULLER, JILL E	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 11/16/2004

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/876,760  
Filing Date: June 07, 2001  
Appellant(s): SCHEUBER ET AL.

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Charles B. Elderkin  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed September 20, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The rejection of claims 5-7 and 11-14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 8-10 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

4,681,348	Mowry, Jr.	7-1987
4,983,990	Frohlich	1-1991
2,084,026	Gurwick	6-1937
4,538,161	Reist	8-1985

"1933: The First Comic Book" by Mike Benton, found at:

[http://www.comicbooklife.com/pag/Benton/BentonCBA\\_1933.html](http://www.comicbooklife.com/pag/Benton/BentonCBA_1933.html)

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5, 7-8, 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,681,348 to Mowry, Jr. in view of U.S. Patent No. 4,983,990 to Fröhlich.

Mowry, Jr. shows a method of providing text on a printed surface, 20, of a printed product, 10, comprising the steps of applying a partially transparent contrast panel, 40, to the printed surface by printing the contrast panel onto the printed surface, with the contrast panel allowing the printed surface of the printed product, 20, to be seen therethrough, see Fig. 3, and forming information within or on the contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read, wherein the step of forming information within or on the contrast panel comprises forming blank areas within the contrast panel, with the blank areas forming the information. See column 1, lines 49-55 and Fig. 3 in particular.

Mowry, Jr. does not teach providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel.

Fröhlich teaches providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream, see column 2, lines 55-59, such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel. See column 3, lines 55-57.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the printing steps of Mowry, Jr. with the printing method of Fröhlich in order to provide text on the borders of a plurality of printed articles in an efficient, automated manner.

3. Claims 6, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mowry, Jr. in view of Fröhlich as applied to claims 5, 7-8, 10-11 and 13 above, and further in view of Gurwick.

Mowry Jr. and Fröhlich teach all that is claimed, as in the above rejection of claims 5, 7-8, 10-11 and 13, except that the step of forming information within or on the contrast panel comprises printing the information onto the contrast panel.

Gurwick teaches a method of forming information, 18, within or on a contrast panel, 16, by printing the information onto the contrast panel. See page 3, lines 9-21.

It would have been obvious to one having ordinary skill in the art at the time of the invention to form information on the contrast panel of Mowry, Jr., as combined with Fröhlich by printing the information, as taught by Gurwick, in order to provide additional contrast between the panel and the information.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mowry, Jr. in view of Fröhlich as applied to claims 5, 7-8, 10-11 and 13 above, and further in view of U.S. Patent No. 4,538,161 to Reist.

Mowry, Jr. and Fröhlich teach all that is claimed, as in the above rejection of claims 5, 7-8, 10-11 and 13 except that the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

Reist teaches a conveyor system, 11, comprising a plurality of clamps, 13, arranged one behind the other in the conveying direction for gripping respective ones of printed products.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the conveyor system of Reist with the invention of Mowry, Jr. and Fröhlich in order to move the printed products through the printing process in a well-controlled manner.

5. Claims 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over "A Century of Comics", (as discussed in the article entitled "1933: The First Comic Book" by Mike Benton) in view of U.S. Patent No. 4,983,990 to Fröhlich.

The first paragraph of the article describes the comic books as "four-color, tabloid-sized" magazines. These magazines would therefore have been produced using

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a four-color printing process, as discussed in the enclosed article "Understanding Color" by John C. Lee.

Using this information, it can be seen that "A Century of Comics" shows a method of providing text on a printed surface of a printed product, consider the first layer of colored printing for the balloon in the cover illustration, comprising the steps of applying a partially transparent contrast panel to the printed surface by printing the contrast panel onto the printed surface, with the contrast panel allowing the printed surface of the printed product to be seen therethrough, consider the second layer of color printing for the balloon, using partially transparent ink so that the original layer of printing can be seen through the second layer, and forming information within or on the contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read, consider the text on the surface of the balloon, wherein the step of forming information within or on the contrast panel comprises printing the information onto the contrast panel.

"A Century of Comics" does not teach providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel.

Fröhlich teaches providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream, see column 2, lines 55-59, such that a border region of each printed product is



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exposed by the imbricated overlap as each printed product passes printing stations along the path of travel. See column 3, lines 55-57.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the printing method of "A Century of Comics" with the printing method of Fröhlich in order to provide text on the borders of a plurality of printed articles in an efficient, automated manner.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over "A Century of Comics" in view of Fröhlich as applied to claims 5-13 above, and further in view of U.S. Patent No. 4,538,161 to Reist.

"A Century of Comics" and Fröhlich teach all that is claimed, as in the above rejection of claims 5-13 except that the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

Reist teaches a conveyor system, 11, comprising a plurality of clamps, 13, arranged one behind the other in the conveying direction for gripping respective ones of printed products.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the conveyor system of Reist with the method of "A Century of Comics", as modified by Fröhlich in order to move the printed products through the printing process in a well-controlled manner.

**(11) Response to Argument**

Applicant's argues that claims 5, 7-8, 10-11 and 13 are not unpatentable over Mowry in view of Fröhlich.

In response to applicant's argument that Mowry is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the broad definition of the field of technology as that of printing, in the case of both the application and the reference, is appropriate because there is no language in the claims which narrows the definition beyond the application of printed text and information to a plurality of printed products. For example, appellant argues that one skilled in the former field of technology would not look to the latter field of technology to deal with the problems associated with applying labels to printed products which are being processed in an imbricated stream at high speeds. However, applicant's claims do not include these features.

Also, although the applicant asserts that the application and reference do not solve the same problem, it is not clear how this is the case. Both the application and the reference produce printed materials where there is text which can be read through another layer of printed text. Although it is this examiner's position that the applied prior art is within the field of applicant's endeavor, it is clear that the second test of analogous

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art has been met and, as required, the teachings of the reference are reasonably pertinent to the problem claimed in the application.

In response to applicant's argument that there is no suggestion to combine Mowry and Fröhlich, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one having ordinary skill in the art would recognize the advantage of providing documents such as those in Mowry to a printer in an imbricated stream, as taught by Fröhlich in order to be able to print them more efficiently, with less waiting time between each operation. Applicant's argument that the process would not be used on mass produced articles because of the expense contradicts the fact that checks such as those in Mowry are often mass produced. Also, one having ordinary skill in the art, wanting to achieve the benefits of the combination, would modify the combination as proposed regardless of whether or not there may be additional costs. Applicant's argument that the combination of the processes would be unsuitable for use because of the movement and rough handling involved, discounts the abilities of one skilled in the art to adapt the combination to overcome these difficulties in light of the advantages of the combination.

In response to applicant's argument that claims 8-10 define the method with more particularity, in which the underlying printed text and the printing on the label can

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be seen and read, these claims do not further distinguish the application from the references as already discussed.

Applicant argues that claims 5-13 are not unpatentable over “A Century of Comics” in view of Fröhlich.

In response to applicant’s argument that the underlying layer of the four color printing cannot be “seen through” later applied layers, it should be noted that, by definition, anything printed on a layer can be seen through a transparent ink. There is no requirement in the claims to distinguish that the text on the lower layer must be different in format or content from the additional layers, merely that it can be easily see and read.

In response to applicant’s argument against using the four-color printing process on articles being conveyed in an imbricated stream, as above, it would be obvious to one having ordinary skill in the art that the process of four-color printing could be modified to take advantage of the increased efficiency offered by providing articles to the printer in an imbricated stream.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



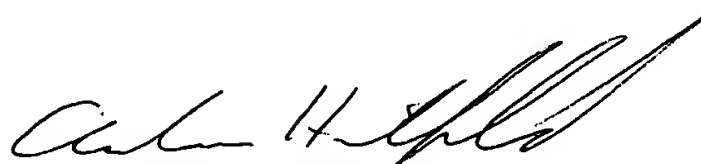
Jill E. Culler

November 9, 2004

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